

In re: Malik  
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Filed: April 20, 2001  
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### **REMARKS**

Claims 1-49 are pending. Claims 1-2, 4, 6-9, 11-14, 16-19, 21, 23-26, 28-30, 32-35, 37, 39-42, 44-46 and 48-49 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,542,420 to Goldman et al. ("Goldman"). Claims 3, 10, 20, 27, 36 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Goldman in view of U.S. Patent No. 6,589,169 to Surwit et al. ("Surwit"). Claims 5, 15, 22, 31, 38 and 47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Goldman in view of the article entitled "The email doctor who only makes mouse calls" by Zoe Morris ("Morris").

Applicant has amended independent Claims 1, 8, 18, 25, 34 and 41 to clarify Applicant's invention. Applicant respectfully traverses the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 for at least the reasons set forth below.

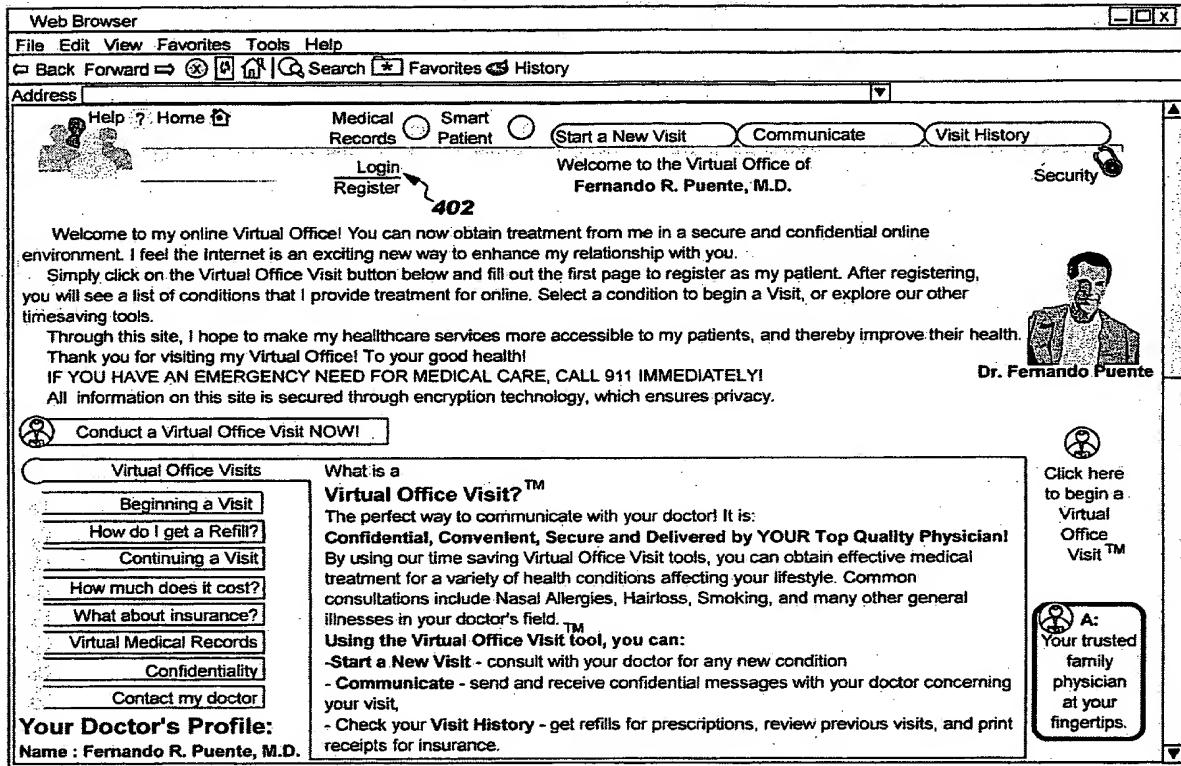
### Applicant's Invention

Applicant's claimed invention is directed to *web-based* systems, methods, and computer program products for providing secure, on-line communications between professional service providers and remotely located individuals (referred to as "clients"). Embodiments of Applicant's invention may be utilized in various professional service industries including, but not limited to, health care, legal services, technical services, and financial services.

According to embodiments of Applicant's invention associated with the healthcare industry, a patient accesses a "virtual office" of a healthcare provider via a web browser. Upon identifying the patient as an existing patient, or accepting the patient as a new patient, the virtual office verifies that the patient is eligible to receive healthcare services. Once verified, the virtual office obtains various personal and medical information from the patient during the patient's "virtual visit." Using the information obtained during the patient's virtual visit, the patient is assigned to a pool, or queue, of patients based upon one or more attributes of the patient and/or one or more attributes of one or more healthcare providers (e.g., physicians). A physician qualified to treat patients in the pool selects the patient from a displayed list and views the medical condition of the patient. The physician prepares a diagnosis and/or treatment recommendation for the medical condition(s) of the patient and sends a communication containing the same to a secure area. The patient is then notified of the physician's communication and is directed to log-on to the secure area and view the communication.

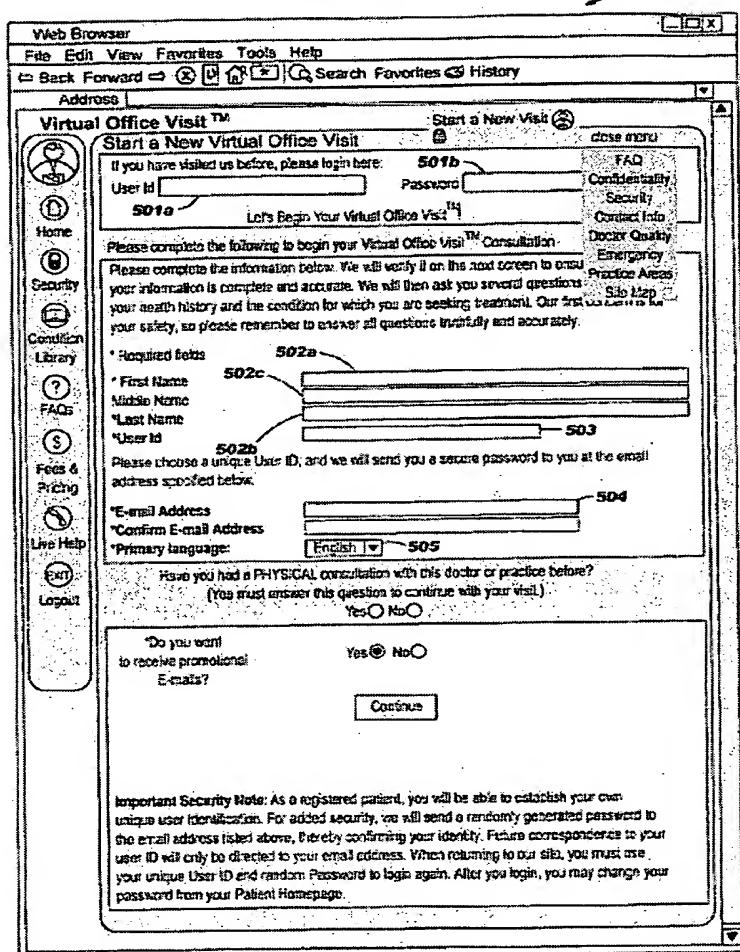
**Fig. 5** from Applicant's application is set forth below and illustrates how a patient accesses a "virtual office" of a healthcare provider via a web browser.

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In response to activation of the "Login" icon 402 of Fig. 5, a patient log-in screen 500 is presented to a patient, as illustrated in Fig. 6.

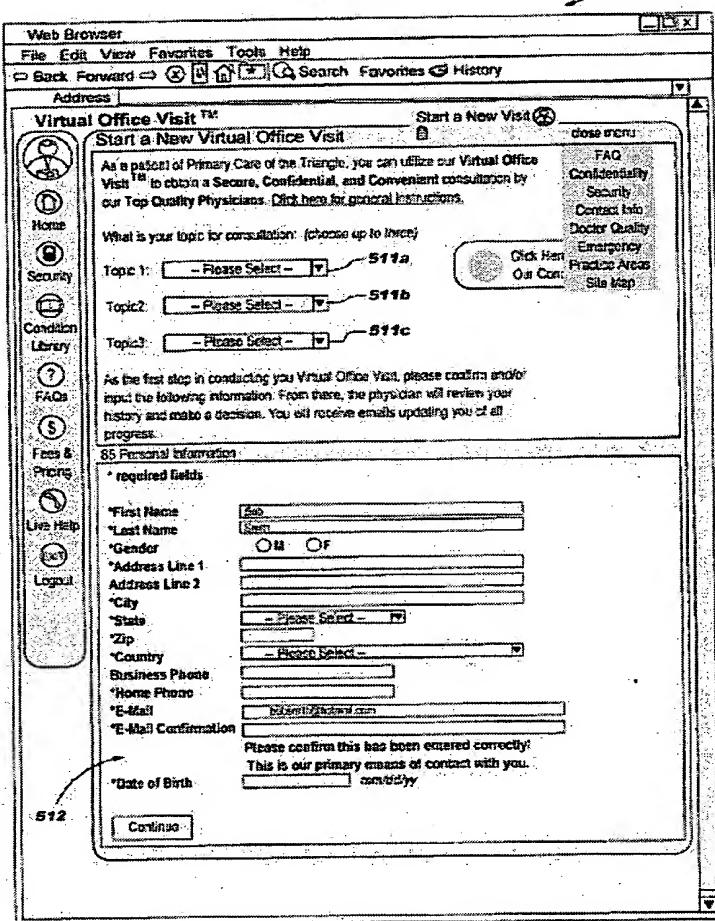
FIG. 6



Once the patient is registered, the patient is presented with a screen 510 (Fig. 7) in which the patient provides information about this visit. The patient selects a medical condition topic for the consultation from one or more of the pull down menu boxes 511a, 511b, 511c. Personal information for the patient is retrieved from storage and displayed within the fields in the portion of the screen 510 generally referred to as 512.

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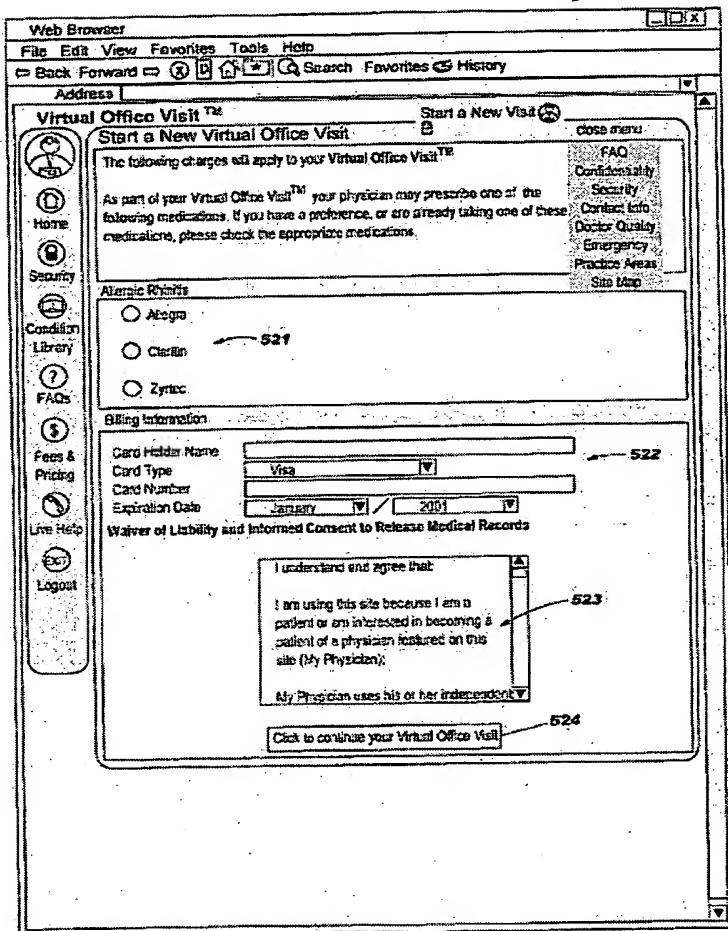
FIG. 7



The next screen presented to the patient is screen 520 (Fig. 8A). In screen 520, the patient is prompted to select specific prescription medication they would like to use for treating their medical condition from a list 521 of medications.

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FIG. 8A



The patient continues by providing answers to general medical history questions via screen 530 (Figs. 9A-9C). The patient answers questions related to lifestyle 531, vital statistics 532, current medications the patient is taking 533, surgical history 534, family medical history 535, and general medical history 536.

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FIG. 9A

This screenshot shows the initial "Start a New Visit" screen of the Virtual Office VisitTM software. It includes a sidebar with icons for Home, Security, Condition Library, FAQs, Fees & Pricing, Live Help, and Logout. The main area displays a "Security Note" about the privacy of medical information. It asks if the user consumes more than 2 servings of alcohol per day, uses recreational drugs, or tobacco products. It also includes sections for Vital Statistics (height and weight), Current Medications (asking if they are currently taking any), Known Drug Allergies (asking if they have any), and Surgical History (asking if they have had surgery). Buttons for "Next Step" and "Start Visit" are visible.

FIG. 9B

This screenshot shows the "Family Medical History" section of the software. It lists various family medical history questions with "Yes", "No", and "No Answer" radio button options. The questions include: Has anyone in your family had any of the following medical problems? (Heart Disease, High Blood Pressure/hypertension, Stroke, High Cholesterol, Kidney Disease, Liver Disease, Asthma, Seizure disorder or epilepsy, Neurologic disorder, Colon cancer, Breast cancer, Lung cancer, Other cancer); Do you have or have you had any of the following? (Horn Problems, High Blood Pressure/hypertension, Stroke, Kidney Problems, Diabetes or High blood sugar); and a general question about being treated for medical conditions. A "General Medical History" section is also partially visible at the bottom.

FIG. 9C

This screenshot shows the "General Medical History" section of the software. It lists numerous medical history questions with "Yes", "No", and "No Answer" radio button options. The questions include: Diabetes or high blood sugar?, Cancer?, Liver Problems?, Gall Bladder Problems?, Stomach or intestinal Problems?, Pulmonary or respiratory problems?, Asthma?, Musculoskeletal problems?, Thyroid or endocrine disorder?, Allergic disorder?, Epilepsy or seizure disorder?, Blood clots or phlebitis?, Gential disorder?, Neurological problems?, Psychiatric problem?, Frequent Headaches?, Significant trauma?, Skin problems?, Other chronic problems?, and Are you being treated for any medical conditions at this time?. At the bottom, it asks if the user has been examined by a healthcare provider within the last 12 months, referencing Harrison's General Principles of Medicine. A "Update General Medical History" button is located at the bottom right.

In Figs. 10A-10B, the patient continues by providing answers to specific medical questions for the medical condition for which the patient is seeking treatment via screen 540. Screen 540 is a physician-designed template that is specially designed to invoke answers to questions related to the particular medical condition of the patient. The answers provided by the patient allow a healthcare provider to determine whether or not the patient will respond favorably to medication or other treatment plan that the healthcare provider would generally provide to treat the patient's medical condition.

FIG. 10A

Web Browser

Virtual Office Visit TM

Start a New Visit

get more info here

Address:

Specific Men's Impotence Questions

\*Answer Required

\*Do you feel you have adequate interest in sex?  Yes  No

\*How long have you felt sexually dysfunctional?

\*Do you have a problem achieving or maintaining an erection sufficient for sexual intercourse?  Yes  No

\*During intercourse, do you find it difficult to maintain your erection after you have entered your partner?  Yes  No

\*Do you feel your penis is crooked?  Yes  No

\*Have you used a method or treatment for erectile dysfunction in the past?  Yes  No

\*Describe the method or treatment you used for erectile dysfunction.

If none, please type "None". If you are on Viagra now, please state here with dose that was effective.

Please describe anything else in your sexual history that would help your doctor understand your problem.

540

Virtual Office Visit TM

Start a New Visit

get more info here

Address:

Specific Men's Impotence Questions

\*Answer Required

\*Do you feel you have adequate interest in sex?  Yes  No

\*How long have you felt sexually dysfunctional?

\*Do you have a problem achieving or maintaining an erection sufficient for sexual intercourse?  Yes  No

\*During intercourse, do you find it difficult to maintain your erection after you have entered your partner?  Yes  No

\*Do you feel your penis is crooked?  Yes  No

\*Have you used a method or treatment for erectile dysfunction in the past?  Yes  No

\*Describe the method or treatment you used for erectile dysfunction.

If none, please type "None". If you are on Viagra now, please state here with dose that was effective.

Please describe anything else in your sexual history that would help your doctor understand your problem.

540

FIG. 10B

Web Browser

Virtual Office Visit TM

Start a New Visit

get more info here

Address:

\*Are you taking any antidepressants?  Yes  No

\*Are you taking any antibiotics?  Yes  No

\*Are you taking any oral antifungal medications?  Yes  No

\*Do you have a bleeding disorder?  Yes  No

\*Are you or have you been treated for an ulcer?  Yes  No

\*Have you ever been told you have angina or other heart conditions?  Yes  No

\*Do you take any medications to lower your blood pressure?  Yes  No

\*Have you ever been told that you have decreased or abnormal kidney function?  Yes  No

\*Do you understand what a nitroglycerin or a nitrate is?  Yes  No

If you do not understand what a nitrate is, please [click here](#).

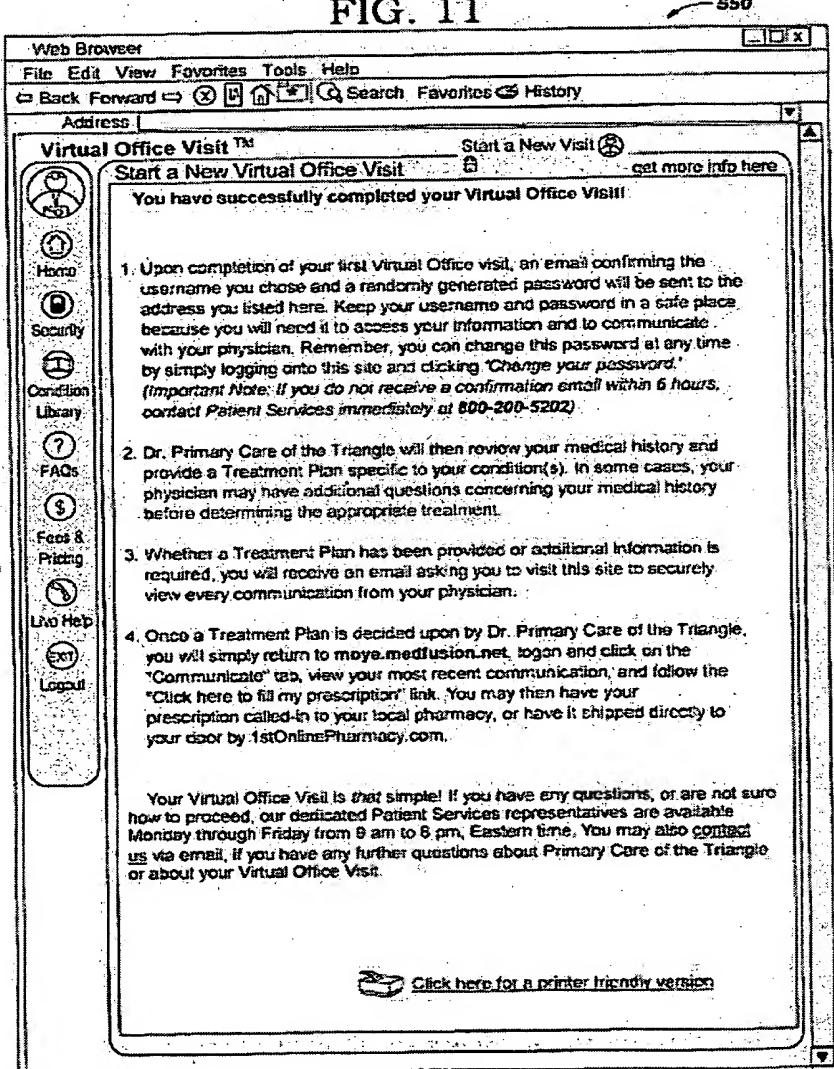
\*Do you understand that taking Viagra while you are on a nitrate can cause your blood pressure to drop to a potentially fatal level?  Yes  No

\*Do you take any medication classified as a nitrate in any form?  Yes  No

Continue

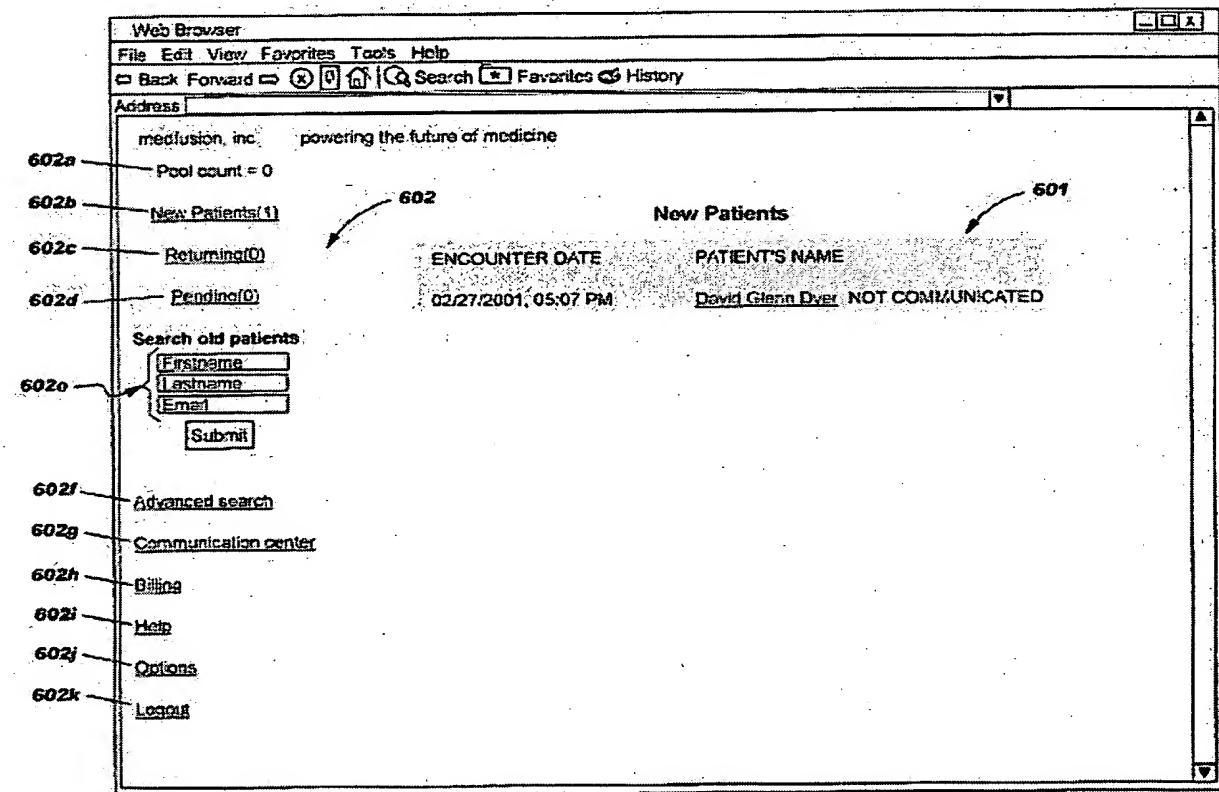
After providing information in above-described screens **500-540**, the patient is presented with screen **550** (Fig. 11) which notifies the patient that the patient has successfully completed a virtual office visit. Moreover, the patient is notified that the secure, on-line consultation will be reviewed by a healthcare provider within a specified period of time (e.g., within the next 12-24 hours), and that the patient will be receiving an e-mail message, or other communication, that will prompt the patient to log-in to a secure area to view a communication with a healthcare provider.

FIG. 11



Each healthcare provider has a profile that specifies the healthcare provider's field of healthcare, as well as other factors that are considered when assigning the healthcare provider to a pool of patients, such as licensing issues. Each healthcare provider is designated as acceptable to provide healthcare services to a particular pool of patients based upon this profile.

If any new patients have completed a virtual office visit, as described above, they will appear in the illustrated screen 600 of Fig. 12 under the "New Patients" heading 601 for a healthcare provider that is allowed to service patients in the particular pool, based upon his/her profile. Information included under the illustrated New Patients heading 601 includes encounter date and time, patient name, whether or not the patient has been communicated with, and what physician group or individual the patient belongs to.



Adjacent the New Patients heading **601** are a plurality of navigation links indicated generally as **602**. The first link "Pool Count" **602a** indicates how many patients are currently in the pool for which the particular healthcare provider is authorized to diagnose and treat patients as well as patients that have selected this physician to perform services for them. For example, a patient who resides in North Carolina and has the medical condition of "male impotence", will be placed in a healthcare provider's pool who fits this patient's profile. The next link "New Patients" **602b**, upon activation, presents a listing of new patients. The healthcare provider can select a patient from the list to initiate a secure consultation with the particular new patient.

The next link "Returning" **602c**, upon activation, presents a list of returning patients. The healthcare provider can select a patient from the list to initiate a secure consultation with the particular returning patient. Consultations with returning patients are conducted in a similar manner as consultations with new patients. Returning patients generally have received treatment, for example, in the form of prescription medication, and are seeking to continue their treatment. The system typically asks returning patients specific questions regarding how they reacted to previously prescribed medication or treatment plan.

The next link "Pending" **602d**, upon activation, presents a listing of patients who are pending for treatment. Pending patients are patients with whom the healthcare provider has communicated with and from whom the healthcare provider is awaiting additional information. Typically, the healthcare provider is awaiting the additional information in order to make a decision whether or not to treat the patient with prescription medication or another treatment plan. Upon activation of a patient link under the New Patients heading **601** in screen **600** of Fig. 12, the particular patient's profile is displayed to the healthcare provider as illustrated in screen **610** of Figs. 14A-14B.

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Web Browser

File Edit View Favorites Tools Help

Back Forward Home Search Favorites History

Address: 612

medfusion, inc. powering the future of medicine Home Logout FAQ Contact Us Search Location Dr. Jonathan Dough

Patient Basic Family Labs & Condition Patient

Profile Health History Procedures Specific Answers Chart

**David Glenn Dyer**

(Hair Loss) Age: 39 Sex: M Height: 70(in) Weight: 205(lbs) State: North Carolina

Communicate Make Notes Take Action

Patient:	No.	Date	Time
Do you consume more than 2 servings of alcohol per day	No	11/7/2000	8:15AM
Do you use recreational drugs	No	11/7/2000	8:15AM
Do you use tobacco products	Yes	11/7/2000	8:15AM
How many cups of a caffeinated beverage do you consume in an average day	2	11/7/2000	8:15AM
Vitals			
Height (in inches)	70	11/7/2000	8:15AM
Weight (in pounds)	205	11/7/2000	8:15AM
Blood Pressure	120/80	11/7/2000	8:15AM
Current Medications			
Current medications	None	11/7/2000	8:15AM
Known Drug Allergies			
Known Drug Allergies	None	11/7/2000	8:15AM
Surgical History			
Description of Surgery/Date of Surgery	None	11/7/2000	8:15AM
Family History			
Heart Disease	No	11/7/2000	8:15AM

FIG. 14A

Web Browser

File Edit View Favorites Tools Help

Back Forward Home Search Favorites History

Address: 610

medfusion, inc. powering the future of medicine Home Logout FAQ Contact Us Search Location Dr. Jonathan Dough

Patient Basic Family Labs & Condition Patient

Profile Health History Procedures Specific Answers Chart

**David Glenn Dyer**

(Hair Loss) Age: 39 Sex: M Height: 70(in) Weight: 205(lbs) State: North Carolina

Communicate Make Notes Take Action

Take Action

Consult #1: - David Glenn Dyer is seeking treatment for Hair Loss

Choose consult status

- Choose consult status
- Prescribe med and communicate
- Provide advice (Medical contraindication from history)
- Provide advice (Does not meet FDA prescribing guidelines)
- Provide advice (Allergic to medicine or has cross sensitivity with an ingredient)
- Provide advice (Unable to establish patient/doctor relationship)
- Communicate only
- Do not charge and communicate

FIG. 14B

614

614a

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After reviewing the information contained in the patient's profile 611, including the patient's answers to the questions presented during the virtual office visit, the healthcare provider is in a position to determine what form of treatment is best for this patient, including whether or not the patient can receive a prescription medication to treat the medical condition.

Also included in the illustrated screen 610 is a "Take Action" heading 614 (Fig. 14B) which includes a pull-down menu box 614a containing a plurality of selectable actions. From the pull-down menu box 614a, the healthcare provider can prescribe prescription medication and communicate in a variety of ways.

In response to selecting an action from box 614a (Fig. 14B), the healthcare provider is presented with screen 620 (Figs. 15A-15B) that includes a pull-down menu 616 for selecting prescription medication (e.g., Propecia® hair loss medication for hair loss) and a pull-down menu 617 for indicating dosage amounts (e.g., 1 tablet daily).

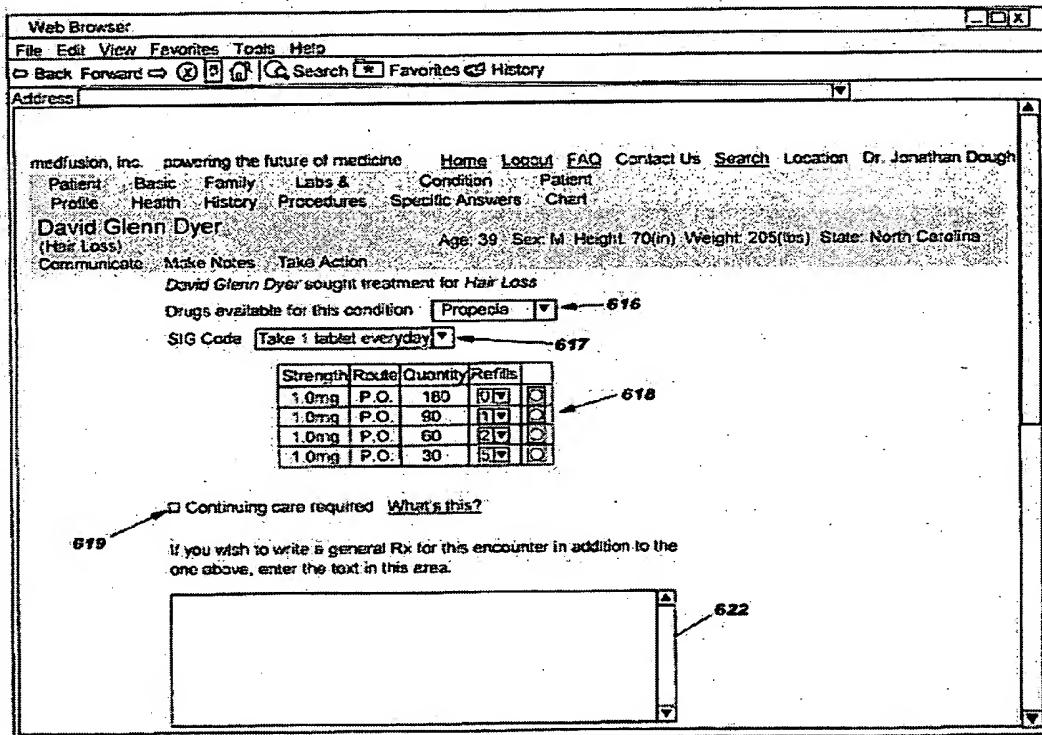


FIG. 15A

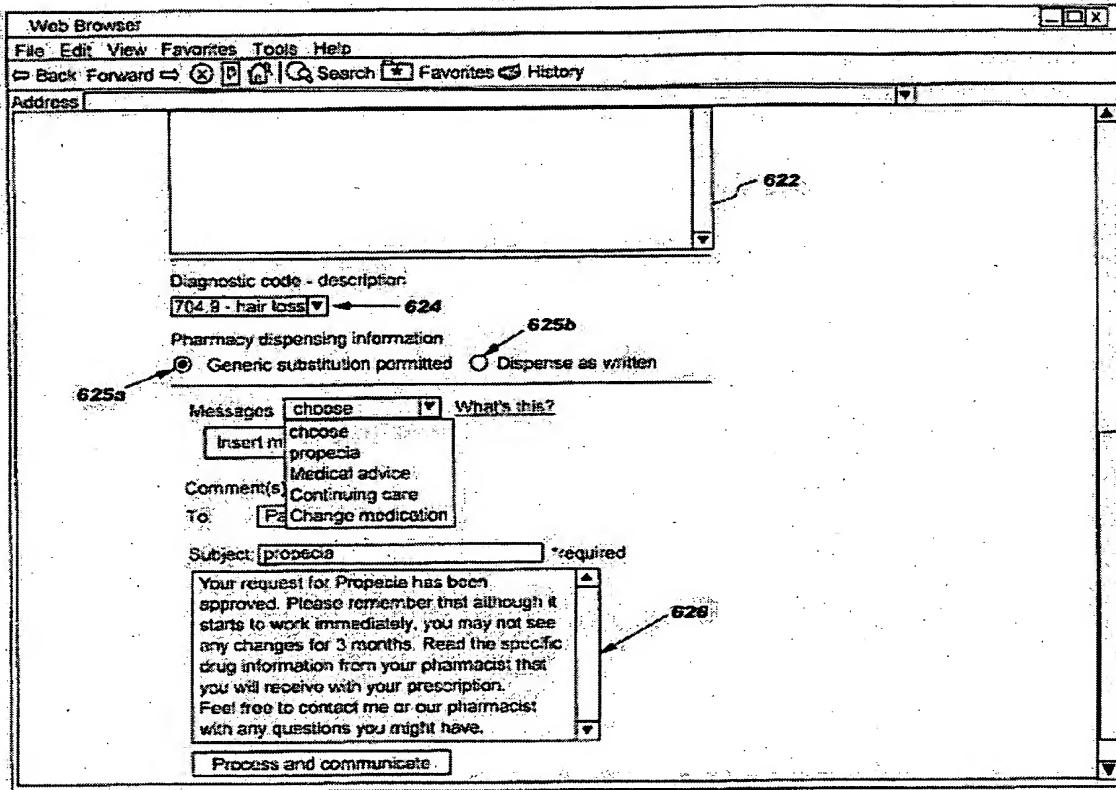


FIG. 15B

In the illustrated screen 620, the healthcare provider also has the option of writing a general prescription via input box 622. Also, the healthcare provider can submit a Diagnostic Code via pull-down menu 624 so that the prescription can be billed to the patient's medical insurance company. Radio buttons 625a, 625b allow the healthcare provider to indicate whether the prescribed medication can have a generic substitution medication 625a, or if the prescription must be filled exactly as prescribed 625b.

The healthcare provider can utilize the communication box 626 in screen 620 to write a message to the patient, or choose a pre-written message on a variety of subjects having to deal with the medication, consumption, or general medical advice.

Referring back to the "Take Action" heading 614 in screen 610 of Fig. 14B, if the healthcare provider does not believe that the patient is a viable candidate for the prescription medication, the healthcare provider can choose an action of communicating to the patient why medication is being refused. As illustrated in box 614a, medication may be refused because of possible contraindications from the patient's medical history, because the

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patient does not meet Federal Drug Administration prescribing guidelines, because the patient may be allergic to the medication or may have a cross sensitivity with an ingredient, and/or because the healthcare provider may not be able to establish a patient/doctor relationship for various reasons.

Once the healthcare provider has taken action (e.g., prescribed and communicated or just communicated to the patient), the healthcare provider can now treat another patient. A notification screen **640** (Fig. 16) appears that confirms that the healthcare provider has completed the consultation for this particular patient.

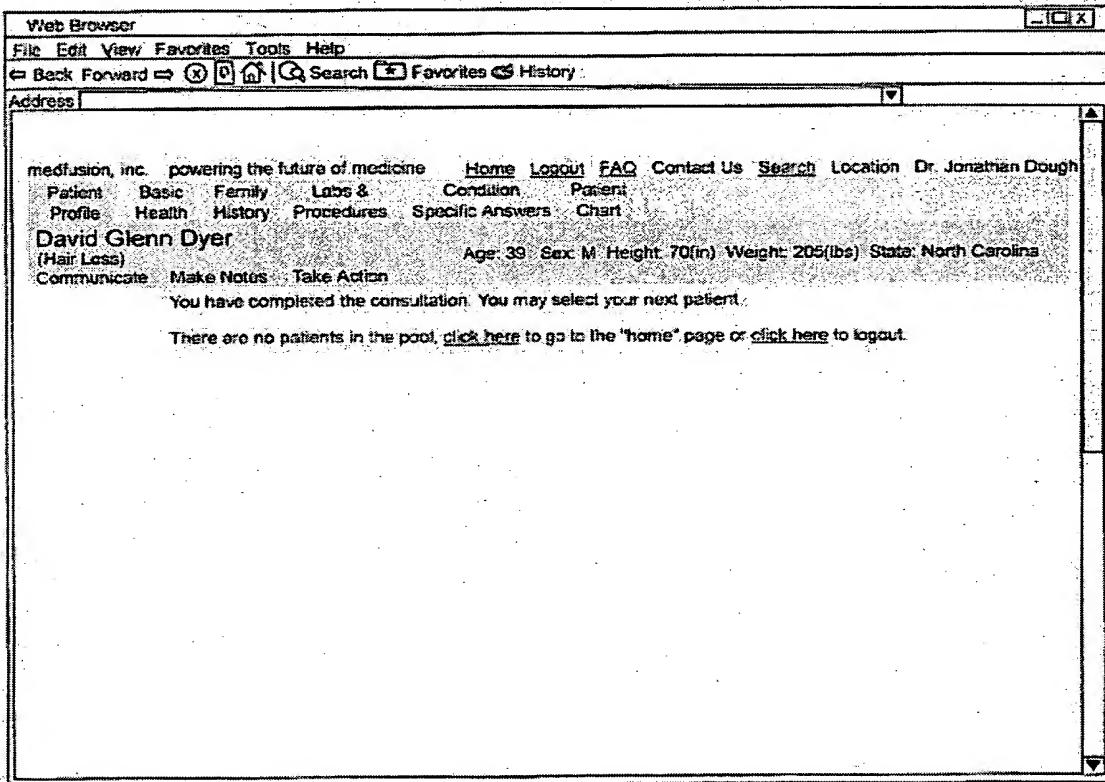


FIG. 16

Referring now to Fig. 17, an e-mail message **700** for the patient is illustrated. The e-mail message **700** notifies the patient that a secure communication from the healthcare provider has been prepared for the patient in response to the patient's virtual office visit. The patient is instructed to log-in to the secure area to view the communication.

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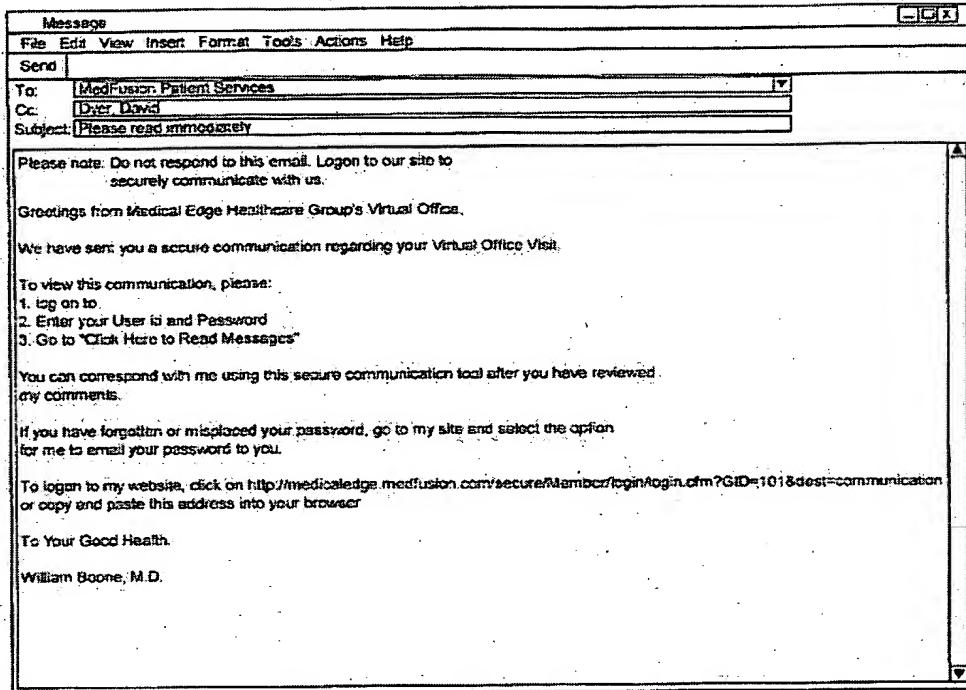


FIG. 17

700

Fig. 18 illustrates an exemplary log-in screen 710 for use by the patient in accessing the secure area.

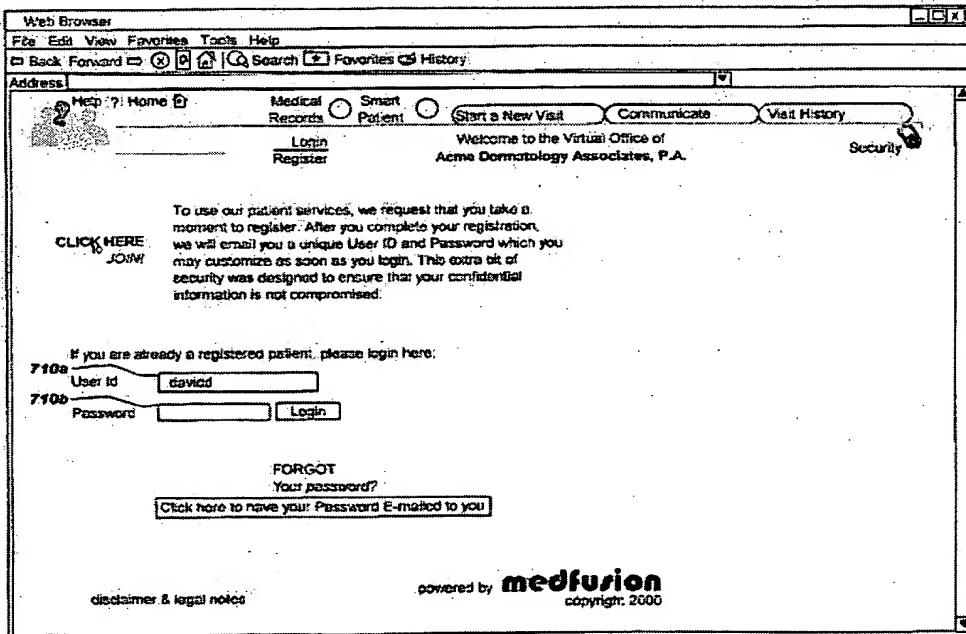


FIG. 18

710

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Upon entering a user ID in field 710a, and a password in field 710b, the patient can access the secure area of the healthcare provider as illustrated by screen 720 of Fig. 19. Via screen 720, the patient can read and respond to communications from the healthcare provider.

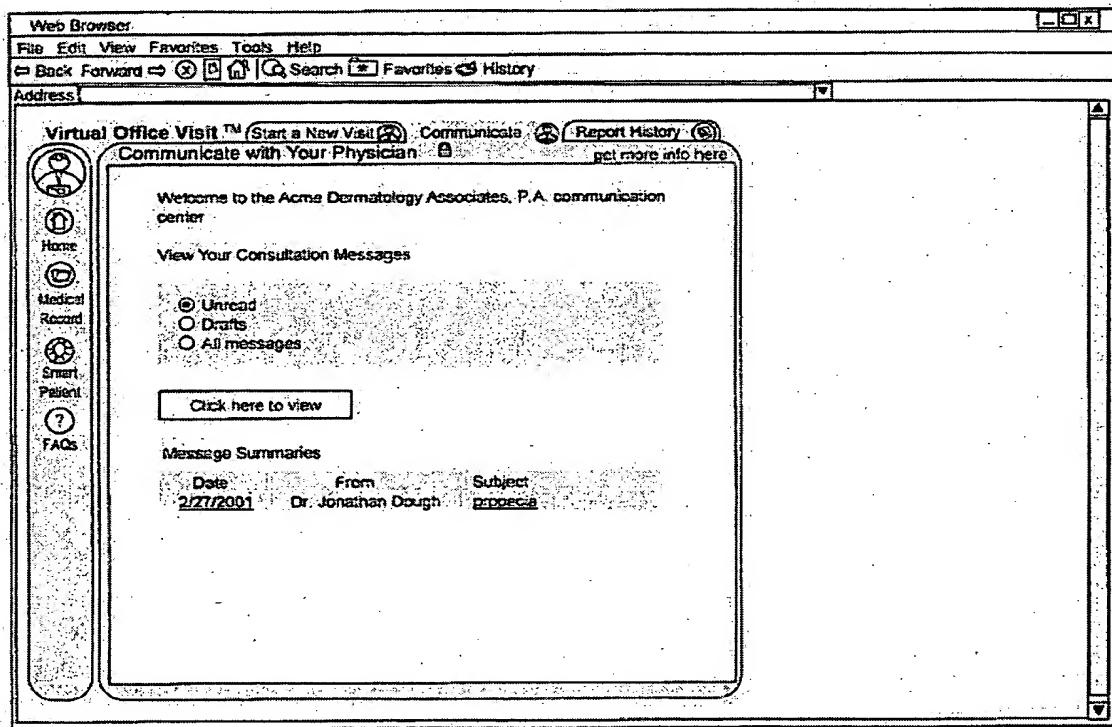


FIG. 19

Screen 730 of Fig. 20 illustrates a communication from the healthcare provider that is being viewed by the patient.

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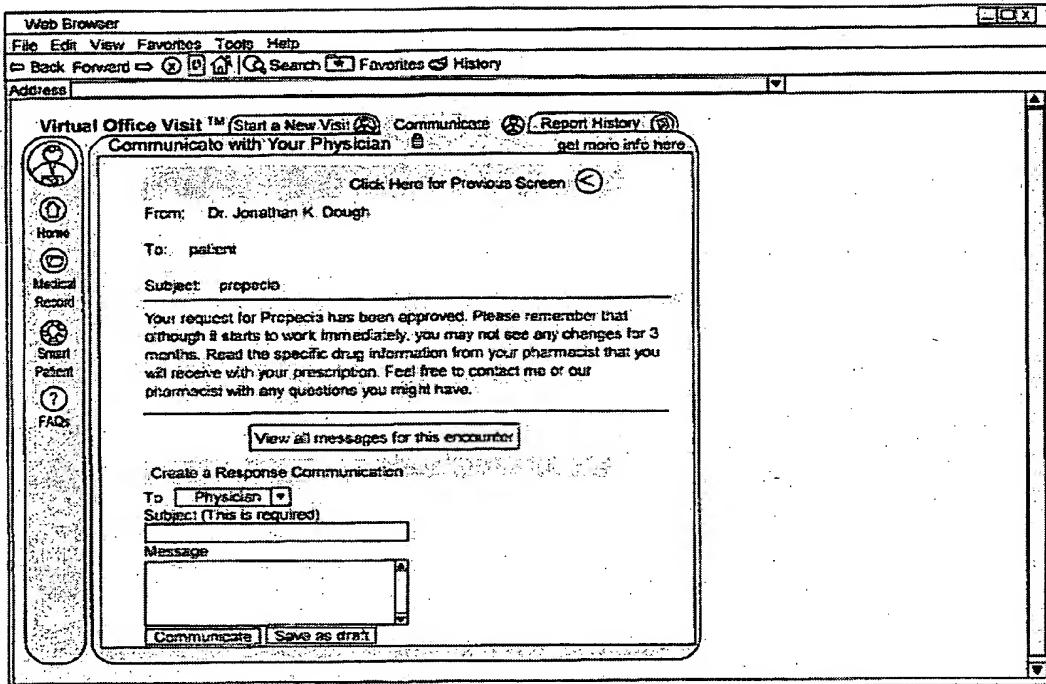


FIG. 20

730

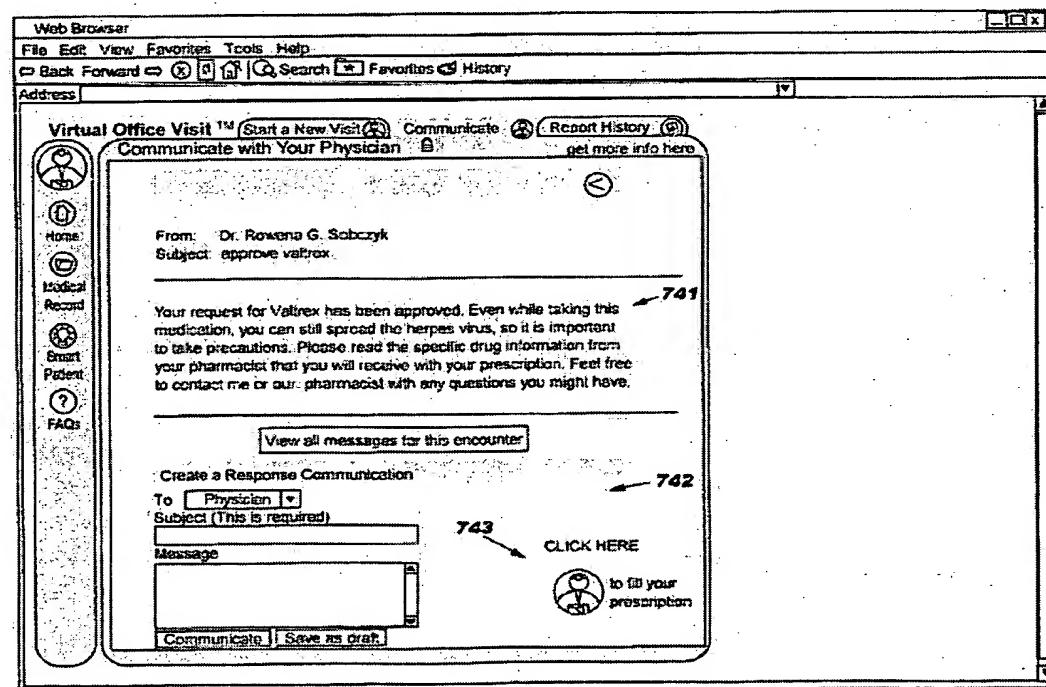


FIG. 21

740

741

742

743

The patient can activate the link 743 to initiate fulfillment of the prescription.

Goldman

Goldman describes a health care system and method for specifying edibles to individual subjects. Various personal, physical, and health data is collected for a subject from a variety of sources (doctor's offices, laboratories, hospitals, wellness centers, etc., as well as, individual subjects themselves). Exemplary information includes: sex, age, weight, type of work performed, along with a multitude of additional information on the habits, health and conditions of the individual including such parameters as blood pressure, blood picture (hematocrit, hemoglobin content, iron content, etc.), urine chemistry. (Col. 6, Lines 10-20). After the basic health and environmental information has been stored for a subject, edible-consumption information is supplied by the individual, typically on-line, at the time of consumption. (Col. 6. Lines 34-37). The personalized and generic data is processed to arrive at recommended intake quantities (RIQ) for an individual subject. That is, the individual's requirements are defined preliminarily setting forth the various edibles including drugs, vitamins, antioxidants, minerals, proteins, fats, carbohydrates and so on for the specific individual. The individual's edible intake is then compared with the recommended intake quantities (RIQs) and a list of deficiencies is generated. (Col. 6, Lines 44-55).

Fig. 2 from Goldman is set forth below and illustrates specific components of the Goldman system.

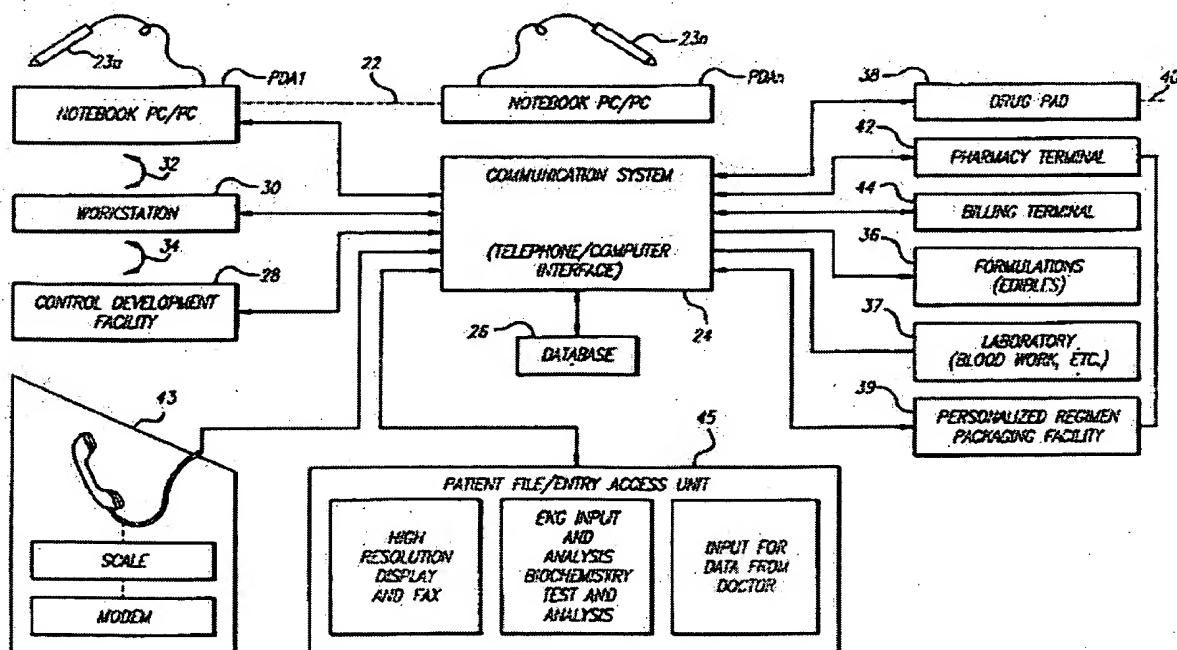


FIG. 2

Notebooks or like computers PDA1-PDAn are provided to patients for use during data acquisition intervals. It is anticipated that most communications from the notebooks PDA1-PDAn will involve telephonic communication. (Col. 7, Lines 65-67).

The data acquisition phase includes two operations. Initially, either the subject, the subject's physician or other health person or entity inputs select items of detailed information to construct a file. The detailed information may be input online or offline via forms, telephone interface, electronic mail, etc. Next, the subject's consumption of edibles is received from the subject and stored over a sampling period as a basis for generating an initial or proposed personalized prescription. (Col. 9, Lines 37-45).

Typically, the information is developed primarily through the telephonic interface as illustrated in FIG. 3.

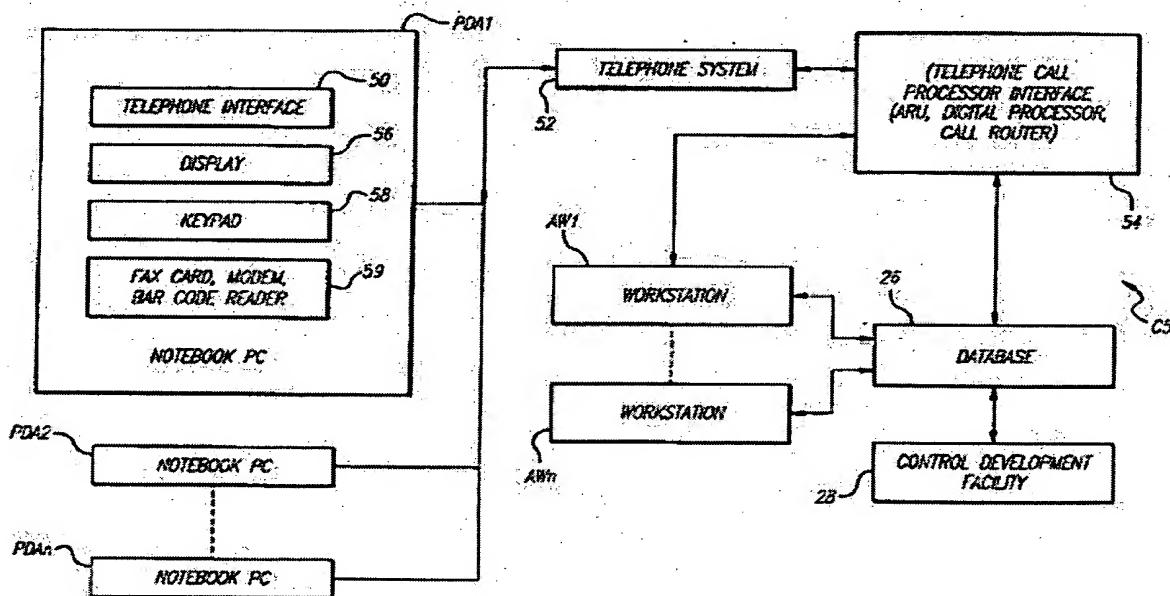


FIG. 3

The subject (or his health care person) is given voice prompts and accordingly replies with keyed digital inputs, or in some instances vocally. A data cell or file on a subject alternatively may be initiated or supplemented by the traditional use of forms. Information on the forms may be subsequently entered by a data entry operator or may be subsequently scanned in by a conventional scanner. Note also that a data cell or file on a subject may be created by the

subject's physician, a wellness center or the like. In some cases, information on non-subscribing individuals may be randomly accumulated from healthcare facilities at no cost to the individual for future use. (Col. 10, Line 54 - Col. 11, Line 1).

The control development facility 28 develops a subject profile and then generates a proposed personal prescription of edibles for the individual subject. (Col. 12, Line 38 - Col. 14, Line 18). The personalized prescription is communicated to and generated for implementation by a formulations unit 36 and/or a drug pad 38 (Fig. 2). The drug pad 38 and the formulations unit 36 may vary depending on the form of the prescription. In that regard, a form of personalized prescription facility 39 may implement the personalized prescription in the form of edibles. Edibles may take the form of a packaged drug regimen (FIG. 7 and 7a) including an array of backed bubbles, for example, a 4 x 7 array labeled as shown in FIG. 7. A personalized regimen packaging facility is indicated at 39 (FIG. 2) where such packaged drug regimens may be assembled, monitored or supervised by a pharmacist. (Col. 8, Lines 34-60).

**§102 Rejections Are Overcome**

A claim is anticipated under 35 U.S.C. §102 if each claimed element is found in a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991); *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 138 (Fed. Cir. 1986). There must be no difference between the claimed invention and the reference disclosure, as viewed by an ordinary artisan. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d at 1576.

As viewed by the ordinary artisan, there is *substantial* difference between Applicant's invention as claimed in independent Claim 1 and the Goldman system and method of specifying edibles to individual subjects. Applicant's invention is directed to web-based systems, methods and computer program products that allow professional services providers and their clients to have "virtual visits" with each other in secure, on-line, web-based "virtual offices." The Goldman system and method is not web-based and does not provide or utilize a secure, web-based "virtual office" for communications between professional service providers and their clients. Goldman telephonically receives information from subjects and then produces a drug regimen in blister pack format for the subjects.

According to an embodiment of Applicant's invention associated with the healthcare industry, a patient accesses a "virtual office" of a healthcare provider via a web browser. Upon identifying the patient as an existing patient, or accepting the patient as a new patient, the virtual office verifies that the patient is eligible to receive healthcare services. Once verified, the virtual office obtains various personal and medical information in a predetermined, structured format from the patient during the patient's "virtual visit." Using the information obtained during the patient's virtual visit, the patient is assigned to a pool, or queue, of patients based upon one or more attributes of the patient and/or one or more attributes of one or more healthcare providers (e.g., physicians). A physician qualified to treat patients in the pool selects the patient from a displayed list and views the medical condition of the patient. The physician prepares a diagnosis and/or treatment recommendation for the medical condition(s) of the patient and sends a communication containing the same to a secure area. The patient is then notified of the physician's communication and is directed to log-on to the secure area and view the communication.

Applicant's independent Claim 1 recites a method of providing professional services, the method comprising the following performed by a web-based data processing system:

- accepting entry of information associated with a matter of a person, wherein the information is entered via a web-based client device in communication with the web-based data processing system;
- assigning the person to one of a plurality of pools of people based on the entered information;
- allowing a professional services provider qualified to advise people in the assigned pool to view the entered information; and
- providing a secure area within which the professional services provider provides information about the matter, wherein the secure area is accessible by the person via the web-based client device.

Independent Claims 8, 18, 25, 34 and 41 contain similar recitations.

Goldman fails to describe all of the recited elements of independent Claim 1. Goldman does not describe a web-based data processing system that is accessible by web-based client devices. Moreover, the Goldman system and method fails to provide a secure area within which a professional services provider provides information about a matter of a person, and wherein the secure area is accessible by the person via a web-based client device. Furthermore, the secure area provided by Applicant's invention is critical to meeting HIPAA requirements that dictate that no personal health information of a patient is communicated in an environment lacking security. The Goldman system and method does not provide a secure area for communicating personal health information sufficient to satisfy HIPAA.

According to Goldman, either a subject, the subject's physician or other health person or entity inputs select items of detailed information to construct a file. The detailed information may be input online or offline via forms, telephone interface, electronic mail. Goldman, however, does not teach or suggest the use of a web-based system for the input of information. Next, the subject's consumption of edibles is received from the subject and stored. Again, Goldman does not teach or suggest the use of a web-based system for the input of a subject's consumption of edibles.

A subject profile is developed and a proposed personal prescription of edibles for the individual subject is generated. However, no web-based secure area is provided that allows the subject and healthcare provider to communicate with each other via web-based

clients. Moreover, neither the subject profile nor the personal prescription are communicated to the subject via a web-based secure area.

The Action cites Col. 3, Lines 40-44 in support of its assertion that Goldman describes providing a secure area. This passage is set forth below:

The system provides access to approved entities, enabling direct communication between remote parties, as well as providing an accurate and comprehensive database of knowledge to ensure personalized care.

Nothing in the cited passage describes a "secure area" or allowing healthcare providers and patients to communicate securely with each other. Specifically, the cited passage fails to describe a secure area within which a professional services provider provides information about a matter concerning an individual subject and wherein the secure area is accessible by the subject using a web-based client device. Taken in context with the paragraph in which the cited passage appears, the "access to approved entities" refers to allowing various entities, including a subject individual, to provide data about the subject individual. However, "access to approved entities" does not refer to a secure area within which the subject individual and professional service provider can communicate back and forth with each other in a web-based environment.

Because Goldman does not disclose all of the recited elements of independent Claim 1, Claim 1 and all claims depending therefrom are not anticipated by Goldman. For at least the same reasons, independent Claims 8, 18, 25, 34 and 41, and all claims depending therefrom, respectively, are not anticipated by Goldman.

Applicant's Claim 2 is dependent from Claim 1 and recites allowing a person to access the secure area and view the information provided by a professional services provider. Claims 9, 19, 26, 35 and 42 contain a similar recitation. The Action cites Col. 18, Lines 22-24 and Fig. 6, Ref. 108 in support of its assertion that Goldman describes allowing a person to access the secure area and view the information provided by a professional services provider. This passage and Fig. 6 from Goldman are set forth below:

Accordingly, a pin number (XXXX), a social security number or other data identifying the subject must be entered as a condition to proceeding.

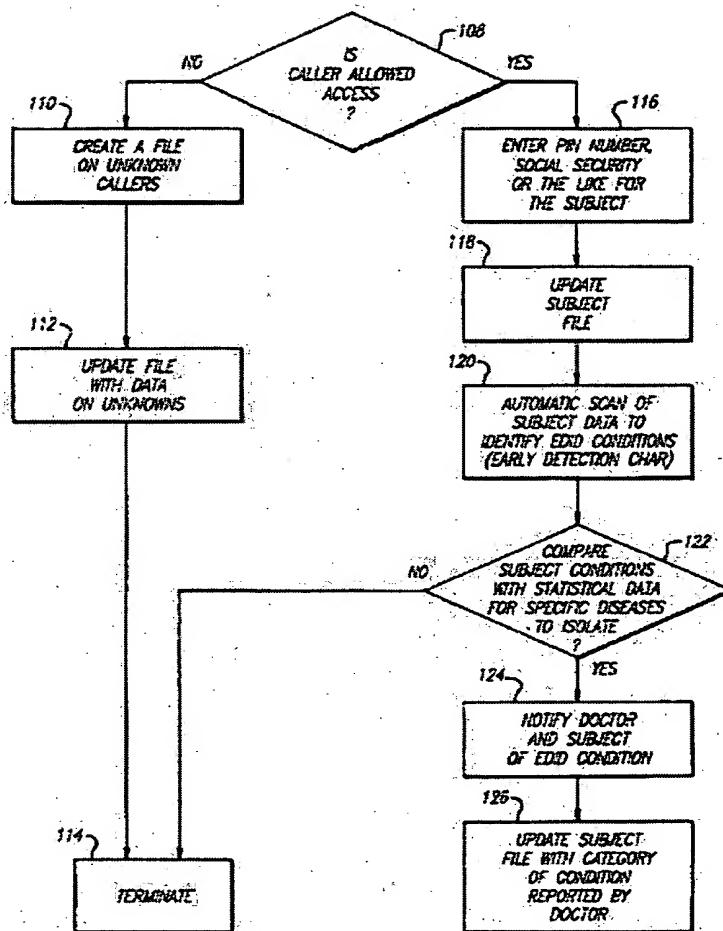


FIG. 6

The cited passage and Block 108 of Fig. 6 describe verifying the PIN of a *calling* entity that is seeking information or providing updates about a subject individual via a telephone. Clearly, the Goldman system and method is a *telephonic* system and method. Nothing in the cited passage, or in Goldman for that matter, describes allowing a person to access a web-based secure area and to *view* information provided by a professional services provider.

Because Goldman does not disclose the recited element of Claim 2, Claim 2 is not anticipated by Goldman. For at least the same reasons, Claims 9, 19, 26, 35 and 42 are not anticipated by Goldman.

Applicant's Claim 4 is dependent from Claim 1 and recites entering information by a person in a predetermined, structured format. Claims 11, 21, 28, 37 and 44 contain a

similar recitation. The Action cites Figs. 7 and 7a in support of its assertion that Goldman describes entering information by a person in a predetermined, structured format.

Figs. 7-7a from Goldman are set forth below:

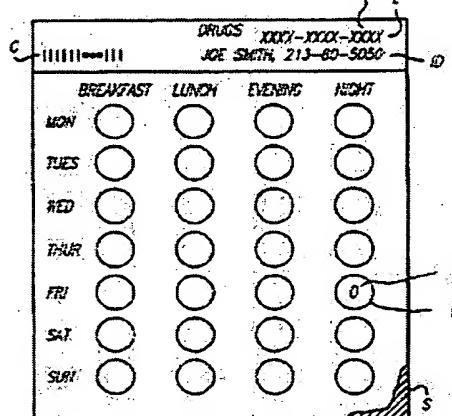


FIG. 7

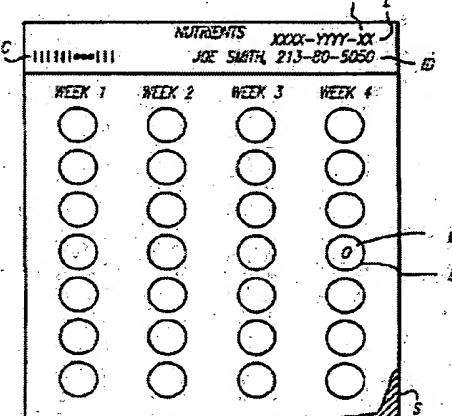


FIG. 7a

Figs. 7 and 7a of Goldman illustrate blister packs containing an array of backed bubbles containing drug regimens for a subject individual. The regimen as illustrated comprises a backing sheet S of cardboard or the like, carrying container bubbles B for individual capsules M. Indicia on the sheet S includes a bar-code indicated at C (FIG. 7) including all pertinent data indicated at L (FIG. 7) along with a subject's identification ID and the ingredients I of the bubble contents.

Clearly, Figs. 7 and 7a of Goldman have nothing whatsoever to do with a person entering information via a client device in a predetermined structured format.

Because Goldman does not disclose the recited element of Claim 4, Claim 4 is not anticipated by Goldman. For at least the same reasons, Claims 11, 21, 28, 37 and 44 are not anticipated by Goldman.

Applicant's Claim 13 is dependent from Claim 8 and recites that a treatment recommendation provided by a healthcare provider includes a request to perform laboratory services on a patient, and also recites communicating the request for laboratory services to a provider of laboratory services for fulfillment. Claims 30 and 46 contain similar recitations. The Action cites Col. 17, Lines 56-59 in support of its assertion that Goldman describes a treatment recommendation that includes a request to perform laboratory services on a patient, and communicating the request for laboratory services to a provider of laboratory services for fulfillment. This passage from Goldman is set forth below:

Entering the patient name and order numbers triggers the automated personalized regimen packaging process. Once the regimens are packaged, they may be directly transmitted to the patient, pharmacy or any intermediate location from where they are to be dispensed to the patient.

The cited passage describes initiating the packaging of personalized drug regimens (*i.e.*, the blister packs illustrated in Figs. 7 and 7a) by entering a patient name and order number. Nothing in the cited passage describes a treatment recommendation provided by a healthcare provider that includes a request to perform laboratory services (*e.g.*, blood tests, x-rays, etc.) on a patient. Moreover, nothing in the cited passage describes communicating a request to perform laboratory services on a patient to a provider of laboratory services for fulfillment.

Because Goldman does not disclose the recited element of Claim 13, Claim 13 is not anticipated by Goldman. For at least the same reasons, Claims 30 and 46 are not anticipated by Goldman.

Applicant's Claim 14 is dependent from Claim 8 and recites that results of laboratory services performed on a patient are communicated to the patient. The Action cites Col. 17, Lines 61-63 in support of its assertion that Goldman describes communicating results of laboratory services to a patient. This passage from Goldman is set forth below:

The system of the present invention processes personal patient files in conjunction with new laboratory analyses, *e.g.*, blood chemistry or urinal analysis to assess potential high health risk situations.

The cited passage, taken in context with the paragraph in which it appears, describes using available information from various sources for detecting critical conditions of patients. Nothing in the cited passage describes communicating to a patient the results of laboratory services performed on the patient. Because Goldman does not disclose the recited element of Claim 14, Claim 14 is not anticipated by Goldman.

Applicant's Claim 17 is dependent from Claim 8 and recites that allowing a patient to access a secure area and view a diagnosis and/or treatment recommendation provided by a healthcare provider comprises allowing the patient to select a specific medication prescription for treating the patient. Claims 33 and 49 contain a similar recitation. The Action cites Col. 15, Lines 9-11 in support of its assertion that Goldman describes allowing a patient to select a specific medication prescription for treating the patient. This passage from Goldman is set forth below:

Such a prescription is then advanced, again with the reviewer's personal identification number (PIN) for tracking and responsibility purposes.

The cited passage, taken in context with the paragraph in which it appears, describes that a reviewer may be authorized to modulate or totally reformulate a proposed personalized prescription for a patient, but that the reviewer, *not* the patient, must enter a PIN for tracking and responsibility purposes. The cited passage does not describe allowing a *patient* to select a specific medication prescription for treating himself/herself.

Because Goldman does not disclose the recited element of Claim 17, Claim 17 is not anticipated by Goldman. For at least the same reasons, Claims 33 and 49 are not anticipated by Goldman.

In view of the above, the rejections under 35 U.S.C. §102 are overcome.

### **§103 Rejections Are Overcome**

A determination under §103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office (USPTO) has the initial burden under § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Court of Appeals for the Federal Circuit also has stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining

whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

*In re Sang Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

Applicant's Claim 3 recites "notifying the person that the professional services provider has provided information about the matter within the secure area." The Action states that Goldman teaches providing medical diagnosis and treatment over a network, but concedes that Goldman fails to teach notifying a person that the service provider had provided information. (Action, Pages 3-4). The Action states that Surwit teaches communication with the patient when a service has been provided and cites Col. 3, Lines 15-18 from Surwit. The Action then concludes that it would have been obvious to one skilled in the art to combine Surwit and Goldman "so as to allow the patient to be aware of the provided information regardless of when and where they are and not have to wait at network device for a response." (Action, Page 4).

For at least the same reasons set forth above with respect to 35 U.S.C. §102, Applicant respectfully asserts that the primary reference, Goldman, fails to teach or suggest various elements of Applicant's amended independent Claim 1 and, because it depends therefrom, Claim 3. Moreover, Surwit fails to teach or suggest notifying a person that a professional services provider has provided information about a matter within a secure area. The cited passage from Surwit is set forth below:

A user may communicate treatment information to a respective patient via a variety of methods including, but not limited to, wireless, satellite, telephone, AVM, e-mail, or facsimile transmission. (Col. 3, Lines 15-18).

Nothing in the cited passage or within Surwit teaches or suggests providing a secure area within which a professional services provider provides information for viewing by a client of the professional services provider and notifying the client that the professional services provider has provided information about a matter within the secure area. Because Goldman and Surwit, alone or in combination, fail to teach or suggest *all* the recitations of Claim 3,

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Serial No.: 09/838,878  
Filed: April 20, 2001  
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Applicant respectfully requests withdrawal of the present rejection of Claim 3 under 35 U.S.C. §103. For at least the same reasons, Applicant respectfully requests withdrawal of the present rejection of Claims 10, 20, 27, 36 and 43 under 35 U.S.C. §103.

Notwithstanding the above, Applicant submits herewith a Rule 131 Declaration of Stephen Nabeil Malik (hereinafter the "Inventor") which establishes that the subject matter of Claims 1-49 of the present patent application was invented prior to the publication date of Morris. The Declaration is accompanied by copies of marketing materials that describe Applicant's claimed invention and that were distributed at a conference held in Las Vegas, Nevada, May 1-3, 2000. These materials clearly establish that Applicant had possession of the subject matter of Claims 1-49 prior to April 2000. Applicant diligently proceeded with filing of Provisional Patent Application No. 60/200,091 on April 27, 2000 after conception prior to April 2000, and with subsequent filing of the present patent application. Accordingly, Morris is not prior art against Claims 1-49. Applicant, therefore, requests that the rejections of Claims 5, 15, 22, 31, 38 and 47 under 35 U.S.C. §103(a) be withdrawn.

In view of the above, it is respectfully submitted that this application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,



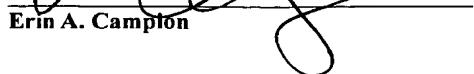
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Erin A. Campion